

Applicants: Eric Rose, et al.
Serial No.: 10/646,493
Filed: August 21, 2003
Page 3

REMARKS

Claims 9 and 38, 43 and 44 are pending in the subject application. Applicants herein amend claim 9 to more particularly point out that which they regard as the invention. Applicants also herein cancel claims 38, 43 and 44 without disclaimer or prejudice. Applicants maintain that this Amendment raises no issue of new matter. Accordingly, upon entry of this Amendment, claim 9 will be pending and under examination.

Objection under 37 C.F.R. §1.75

The Examiner objected to claim 44 as allegedly being a substantial duplicate of claim 43.

In response, and without conceding the correctness of the Examiner's objection, applicants note that claim 44 has been canceled herein. Accordingly, the Examiner's objection is moot.

Priority Claim for Claims 9, 38, 43 and 44

The Examiner alleges that claims 9, 38, 43 and 44 are not entitled to the benefit of the filing date of parent applications PCT Application No. PCT/US97/08282 or of U.S. Serial No. 08/648,561 under 35 U.S.C. §120 because the parent applications do not disclose the specific mutesins recited in claim 9, part (vii) or in claims 38, 43 and 44.

In response to the objection to claims 38, 43 and 44, applicants note that those claims have been canceled herein. Accordingly, the

Applicants: Eric Rose, et al.
Serial No.: 10/646,493
Filed: August 21, 2003
Page 4

Examiner's objection to those claims is moot.

In response to the Examiner's objection to claim 9, applicants note that claim 9, as amended, does not provide a pharmaceutical composition comprising a Factor IXa compound wherein the Factor IXa compound is an inactive mutein form of Factor IXa. Accordingly, applicants maintain that claim 9 is entitled to the benefit of the filing date of parent applications PCT Application No. PCT/US97/08282 and of U.S. Serial No. 08/648,561 under 35 U.S.C. §120.

Rejection under 35 U.S.C. §102(e)

The Examiner rejected claim 9 under 35 U.S.C. §102(e), as allegedly anticipated by Fischer et al. (U.S. Patent No. 6,034,222). Specifically, the Examiner alleges that Fischer, et al. teach pharmaceutical compositions comprising pro-Factor IX, which is used as a Factor IX antagonist. The Examiner further alleges that the term "Factor IX" is synonymous with the term "Christmas factor" as recited in claim 9, therefore, the pro-Factor IX taught by Fischer, et al., corresponds to applicants' inactive Christmas factor.

In response, and without conceding the correctness of the Examiner's rejection, applicant notes that claim 9, as amended, does not recite the term "inactive Christmas factor." Accordingly, the Examiner's rejection is overcome.

Rejections under 35 U.S.C. §102(b)

The Examiner rejected claim 9 under 35 U.S.C. §102(b), as allegedly

Applicants: Eric Rose, et al.
Serial No.: 10/646,493
Filed: August 21, 2003
Page 5

anticipated by Miyata, et al. Specifically, the Examiner alleges that Miyata, et al. teach Factor IX Bm Kiryu, isolated and purified in the form of a buffered saline solution.

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claim 9, as amended, does not recite the term "Factor IX Bm Kiryu." Accordingly, the Examiner's rejection is overcome.

The Examiner further rejects claim 9 under 35 U.S.C. §102(b), as allegedly anticipated by Sakai, et al. Specifically, the Examiner alleges that Sakai, et al. teach a Factor IX variant in which phenylalanine is present instead of the normal valine residue at position 182, and that this corresponds to applicants' inactive Christmas factor recited in claim 9.

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claim 9, as amended, does not recite the term "inactive Christmas factor." Accordingly, the Examiner's rejection is overcome.

Finally, the Examiner rejected claim 9 under 35 U.S.C. §102(b), as allegedly anticipated by Liebman. Specifically, the Examiner alleges that Liebman teaches an isolated Gla-deficient Factor IX which corresponds to applicants' des-γ-carboxyl Factor IX.

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claim 9, as amended, does not recite the term "des-γ-carboxyl Factor IX." Accordingly, the Examiner's rejection is overcome.

Applicants: Eric Rose, et al.
Serial No.: 10/646,493
Filed: August 21, 2003
Page 6

Claim Objection

The Examiner objected to claims 38 and 43 as being dependent upon a rejected base claim.

In response to the Examiner's objection, applicants note that claims 38 and 43 have been canceled herein. Accordingly, the Examiner's objection is moot.

Summary

For the reasons set forth hereinabove, applicants maintain that pending claim 9 is in condition for allowance, and respectfully request allowance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

Applicants: Eric Rose, et al.
Serial No.: 10/646,493
Filed: August 21, 2003
Page 7

No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Alan J. Morrison

5/1/06

Date

Registration No. 37,399

John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
Tel. No. (212) 278-0400